UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,879	01/17/2001	Naohito Takae	1341.1077 (JDH)	4985

21171 7590 06/30/2004	EXAMINER	
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ART UNIT	PAPER NUMBER
2681	8

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.		Applicant(s)
Office Action Summary	09/760,879		TAKAE ET AL.
	Examiner		Art Unit
	Eliseo Ramos-Feliciano		2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 March 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-5,7-9 and 11-17* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-5,7-9 and 11-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Previous objection to the claims is withdrawn in view of amendment filed on March 19,

2004 (Paper No. 7).

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   **Claims 1, 3-5, 7-8, 11-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Henrick (US Patent Number 6,628,940), in view of Svensson (US Patent Number 5,418,837) and

further in view of Hagebarth (US Patent Number 6,484,026).

Regarding **claim 1**, Henrick discloses a portable terminal remote control method of

remotely controlling a portable terminal (105, 206, 605) from an external device (101, 201, 601)

via a wireless communication link (column 7, lines 41-44), said portable terminal having a main

body provided with a built-in memory (database 403 – Figure 4; column 5, lines 61-64; column

2, lines 20-21). See Figures 1, 2, 5, and 6. (Note "information storage" or "database" (403) reads

on "memory" and "cellular telephone terminal" (105, 206, 605) reads on "portable terminal

having a main body"). The method including:

accepting a request (call) by said external device related to a change of setting in said

portable terminal from a user of said portable terminal via the wireless communication link

(column 3, line 63 to column 4, line 7; column 5, lines 58-61; column 6, lines 8-11; column 1, line 66 to column 2, line 18); and

sending a setting changing, by said external device to said portable terminal, in response to the accepted request (column 3, lines 66-67),

wherein the setting changing includes a computer program (software; column 1, line 11; column 5, lines 30-33; column 10, lines 52-53; column 5, lines 9-10) that changes contents of the built-in memory, and a setting changing identifier (indicator; column 5, lines 15-21; column 6, lines 10-15) that identifies the setting changing file.

However, Henrick fails to disclose that the portable terminal includes an attachable/ detachable storage medium, as defined by applicant; nor that the setting changing collectively changes the contents of the built-in memory and the storage medium of the portable terminal, in response to the received request.

Svensson discloses a portable terminal (Figure 1) having a main body (10) provided with a built-in memory (internal memory 30), and an attachable/detachable storage medium (SIM card 40). Svensson teaches cooperation for transferring a message (setting changing file) from the built-in memory (internal memory 30) to the attachable/detachable storage medium (SIM card 40); therefore, a computer program that collectively changes contents of the built-in memory and the storage medium of the portable terminal (abstract; column 2, lines 49-55). Svensson provides the advantage of data loss prevention by memory backup.

Therefore, it would have been obvious at the time the invention was made to provide Henrick with an attachable/detachable storage medium, as taught by Svensson, and collectively

changing the contents of the built-in memory and the storage medium in response to the received

request for the advantage of data loss prevention by memory backup.

The combination of Henrick and Svensson fails to further disclose that the setting

changing is in form of "mail" (electronic mail).

Hagebarth discloses a setting changing of a SIM card memory in a mobile telephone

(column 1, lines 10-15). An electronic mail (e-mail) includes both a message to inform the user

as well as set performance parameters ("setting changing"); (column 7, lines 34-38; column 6,

lines 35-41; column 5, lines 15-19). The advantage of Hagebarth is that electronic mail is easy to

use, cost effective, and widely available.

Therefore, it would have been obvious at the time the invention was made to modify

Henrick and Svensson so that the setting changing is in form of "mail" (electronic mail) because

e-mail is easy to use, cost effective, and widely available; therefore, user-friendly and very

desirable.

Regarding **claim 3**, see the rejection of *claim 1* for the subject matter this claim is

dependent upon. The combination of Henrick, Svensson, and Hagebarth discloses upon

acceptance of the request related to the change of setting in said portable terminal, generating the

setting changing mail containing a computer program suitable to the received request. (Henrick -

column 3, lines 30-38, and column 3, line 67 to column 4, line 9, note whether the "user selects

directory or appointments" reads on "suitable"). The information in the setting changing mail is a

computer program (software; Henrick - column 1, line 11; column 5, lines 30-33; column 10,

lines 52-53; column 5, lines 9-10).

Regarding **claim 4**, see the rejection of *claim 3* for the subject matter this claim is

dependent upon. The combination of Henrick, Svensson, and Hagebarth further discloses upon

acceptance of the request related to the change of setting in said portable terminal from the user

of said portable terminal, checking whether or not the user is an authorized users get, and

generating the setting changing mail only when the user is an authorized user. (see customer

identity verification; Hagebarth – column 5, lines 1-6).

Regarding **claim 5**, Henrick discloses a portable terminal remote control method of

remotely controlling a portable terminal (105, 206, 605) from an external device (101, 201, 601)

via a wireless communication link (column 7, lines 41-44), said portable terminal having a main

body provided with a built-in memory (database 403 – Figure 4; column 5, lines 61-64; column

2, lines 20-21). See Figures 1, 2, 5, and 6. (Note "information storage" or "database" (403) reads

on "memory" and "cellular telephone terminal" (105, 206, 605) reads on "portable terminal

having a main body"). The method including:

receiving a setting changing, sent from said external device (101, 201, 601) in said

portable terminal (105, 206, 605), the wireless communication link, (column 3, line 63 to column

4, line 7; column 5, lines 58-61; column 6, lines 8-11; column 1, line 66 to column 2, line 18),

the setting changing including a computer program(software; column 1, line 11; column 5, lines

30-33; column 10, lines 52-53; column 5, lines 9-10) that collectively changes contents of the

built-in memory, and a setting changing identifier (indicator; column 5, lines 15-21; column 6,

lines 10-15) that identifies the setting changing mail;

identifying the setting changing mail based on the setting changing identifier (indicator;

column 5, lines 15-21; column 6, lines 10-15); and

updating the contents of said built-in memory based on the content of the received setting

changing (column 3, lines 66-67; column 5, lines 58-61; column 6, lines 8-14).

However, Henrick fails to disclose that the portable terminal includes an attachable/

detachable storage medium, as defined by applicant; nor that the setting changing collectively

changes the contents of the built-in memory and the storage medium of the portable terminal, in

response to the received request.

Svensson discloses a portable terminal (Figure 1) having a main body (10) provided with

a built-in memory (internal memory 30), and an attachable/detachable storage medium (SIM

card 40). Svensson teaches cooperation for transferring a message (setting changing file) from

the built-in memory (internal memory 30) to the attachable/detachable storage medium (SIM

card 40); therefore, a computer program that collectively changes contents of the built-in

memory and the storage medium of the portable terminal (abstract; column 2, lines 49-55).

Svensson provides the advantage of data loss prevention by memory backup.

Therefore, it would have been obvious at the time the invention was made to provide

Henrick with an attachable/detachable storage medium, as taught by Svensson, and collectively

changing the contents of the built-in memory and the storage medium in response to the received

request for the advantage of data loss prevention by memory backup.

The combination of Henrick and Svensson fails to further disclose that the setting

changing is in form of "mail" (electronic mail).

Hagebarth discloses a setting changing of a SIM card memory in a mobile telephone

(column 1, lines 10-15). An electronic mail (e-mail) includes both a message to inform the user

as well as set performance parameters ("setting changing"); (column 7, lines 34-38; column 6,

lines 35-41; column 5, lines 15-19). The advantage of Hagebarth is that electronic mail is easy to use, cost effective, and widely available.

Therefore, it would have been obvious at the time the invention was made to modify Henrick and Svensson so that the setting changing is in form of "mail" (electronic mail) because e-mail is easy to use, cost effective, and widely available; therefore, user-friendly and very desirable.

Regarding **claim 7**, see the rejection of *claim 5* for the subject matter this claim is dependent upon. The combination of Henrick, Svensson, and Hagebarth further discloses wherein the storage medium includes a subscriber identity module card (SIM card 40- Svensson, Figure 1) issued by a communication provider, provided with a processor and a memory (by definition of SIM card); so that in the collectively updating of the contents, the main body has a processor (20 - Svensson) that updates the contents of said built-in memory (30 - Svensson) by executing the computer program contained in the setting changing mail, and the subscriber identity module card is updated by a processor-to-processor communication between the processor in said main body and the processor in the subscriber identity module card. (column 2, lines 49-55, *inter alia* - Svensson).

Regarding **claim 8**, see the rejection of *claim 5* for the subject matter this claim is dependent upon. The combination of Henrick, Svensson, and Hagebarth disclose storing the received setting changing mail in the built-in memory; and (see citations above).
In addition, Svensson discloses when the storage medium is replaced with another storage medium, updating contents of the other storage medium by running the computer program

(column 2, lines 46-55) contained in the setting changing mail stored in said internal memory (as already discussed in this claim).

Therefore, at the time of invention it would have been obvious to a person of ordinary skill in the art to add the above teachings of Svensson, to the combination above, for the advantage of transporting information to another phone as suggested by Svensson (column 4, line 14-17). Also for the advantage of data loss prevention by creating multiple backups.

As to **claims 11 and 12**, they are the corresponding system and recording medium claims of method *claim 1*; therefore, they are rejected for the same reasons applied above for *claim 1*.

As to **claim 13**, it is a corresponding system claim of method *claim 5*; therefore, it is rejected for the same reasons applied above for *claim 5*.

As to **claims 14**, it is a method claim broader in scope but corresponding to method *claim 1*; therefore, it is rejected for the same reasons applied above for *claim 1*.

As to **claims 15 and 16**, they are the corresponding system and recording medium claims of method *claim 14*; therefore, they are rejected for the same reasons applied above for *claim 14*.

As to **claim 17**, it is a corresponding system claim of method *claim 4/3/1*; therefore, it is rejected for the same reasons applied above for *claim 4/3/1*.

4.   **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick, Svensson, and Hagebarth as applied to **claim 5** above, and further in view of Hubbe et al. (US Patent Number 6,278,885).

Regarding **claim 9**, see the rejection of *claim 5* for the subject matter this claim is dependent upon. The combination of Henrick, Svensson, and Hagebarth disclose storing the received setting changing mail in said storage medium (see citations above).

However, the combination fails to disclose when said storage medium is inserted into a main body of another portable terminal, updating contents in a built-in memory of the main body of the other portable terminal by running the computer program contained in the setting changing mail stored in said storage medium.

However, Hubbe discloses when said storage medium is inserted into a main body of another portable terminal, updating contents in a built-in memory of the main body of the other portable terminal by running the computer program (abstract, see also column 3, lines 26-35) contained in the setting changing mail stored in said storage medium (as already discussed in this claim).

Therefore, at the time of invention it would have been obvious to a person of ordinary skill in the art to add the above teachings of Hubbe et al. to the combination of Henrick, Svensson, and Hagebarth, to enable a mobile user to, for example, store the directory information in his SIM card to the internal memory of another mobile when the user is using another phone (as suggested by Hubbe, column 4, lines 8-14). Also for the advantage of data loss prevention by creating multiple backups.

Response to Arguments

5.   Applicant's arguments with respect to *claims 1-13* have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Conclusion

7.   Any inquiry concerning this communication from the examiner should be directed to
Eliseo Ramos-Feliciano whose telephone number is 703-305-0078. The examiner can normally
be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Erika A. Gary, can be reached on (703) 308-0123. The fax phone number for the
organization where this application or proceeding is assigned is 703-872-9306.
        Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
applications is available through Private PAIR only. For more information about the PAIR
system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR
system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELISEO RAMOS-FELICIANO
PATENT EXAMINER

ERF/erf
June 26, 2004.

ERIKA GARY
PATENT EXAMINER